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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,427	10/21/2003	Giancarlo Fenzi	FENZI 3 DIV	3827

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EXAMINER

PURVIS, SUE A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/690,427	Applicant(s) FENZI, GIANCARLO	
	Examiner Sue A. Purvis	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/242,994.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

- a. Applicant has amended the specification and the claims replacing the term "section" with the term "profiled bar". Applicant claims support for the addition exists and points to the drawings and portions of the specification. In addition, the applicant defines this term on page 10 of their response as being "a bar with a profiled cross-section which is substantially constant in shape along the length of the profiled bar." This definition is not in the specification and cannot be inferred from any portion of the specification. It is considered new matter.

- b. Applicant has amended claim 1 to state the "nip roller" is "made of elastically complying material." This is not supported by the specification. Applicant points to page 3 of the specification which states "a rotary nip roller from elastically complying and suitably shaped, heated and thermostated material." No where does the specification stated the material the nip roller is **made of** is elastically complying.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pippel et al. (US Patent No. 4,750,965) in view of Shinno et al. (US Patent No. 4,997,510) and Chitwood et al. (US Patent No. 3,574,040).

Regarding applicant claim 1, Pippel discloses an apparatus capable of applying sections of transferable tape (strip-like flexible support) onto a substrate comprising (Figures 1, 3, 6 and 7):

(1) A translating arrangement capable of moving a tape applying means 20 relative to a longitudinal axis of a substrate 22 (Figure 1; column 6, line 37 to column 7, line 68);

(2) An unwinding device (supply reel 70 and motor 84) capable of unwinding a reel (coil) of transfer tape (comprising a strip-like flexible support 74 having a transferable coating 72 thereon) (Figure 3; column 8, lines 3-23);

(3) A rotary nip roller assembly (laydown roller) 60 which is capable of elastically complying (through spring 112) with the surface topography of the substrate 22 to which the tape is to be applied such that the tape is pressed against the surface of the substrate 22 as the tape applying means 20 is translated relative to the substrate 22 (Figures 6, 7 and 14; column 9, lines 36-59); and

(4) A rewinding device (take-up reel 82 and motor 86) capable of rewinding the strip-like flexible support 74 onto a take-up reel (coil) 82 after the transferable coating 72 of

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the tape has been applied to the surface of the substrate 22 (Figure 3; column 8, lines 24-47). The apparatus of Pippel et al. is illustrated below:

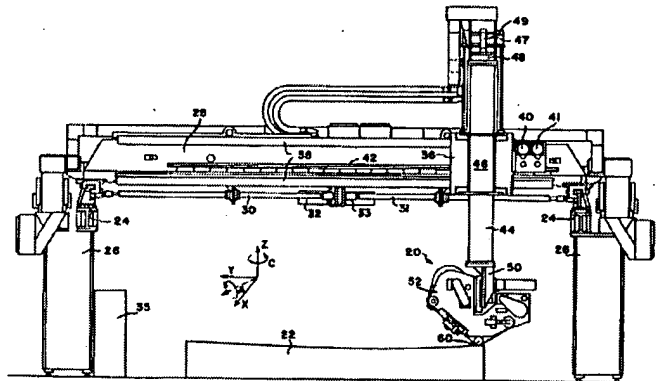


FIG. 1

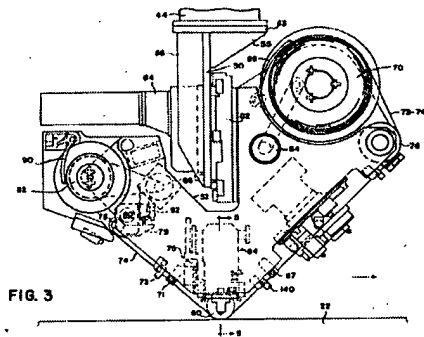


FIG. 3

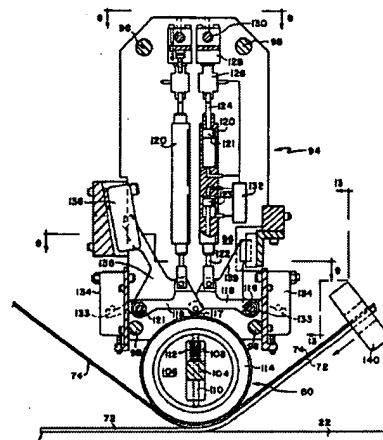


FIG. 7

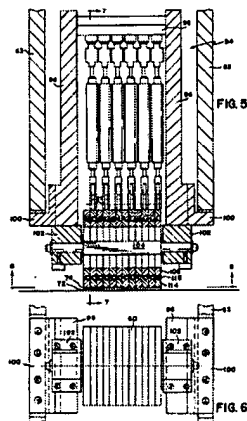


FIG. 5

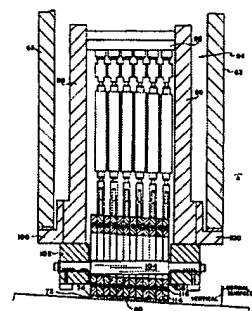


FIG. 14

Pippel, however, does not specifically disclose, as per claim 1, that the rotary nip roller is made of an elastically complying material or that it is heated by way of a heating device.

Nonetheless, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the roller elastically conformable, because Shinno teaches to use a roller with a peripheral portion made of an elastic material so it can deform in accordance with the surfaces to which the material is being applied. (Shinno, Col. 5, lines 52-65.) In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lay down roller assembly 60 of Pippel with a heating device because Chitwood, also drawn to apparatus capable of applying sections of tape onto a substrate, discloses that the simultaneous application of heat to the tape with the application of pressure assures that the desired adhesion of the tape to the substrate takes place by inducing a tackiness in the tape (column 4, lines 5-15). Chitwood discloses that this heating may be accomplished by the inclusion of a heating device directly into the pressure application foot. (Column 6, lines 10-28).

Regarding claim 2, Pippel discloses that the translating arrangement is capable of moving a tape applying means 20 relative to a longitudinal axis of a substrate (section) 22 in both a horizontal X-Y, vertical Z and oblique (rotational) A planes (Figure 1; column 6, lines 42-45).

Regarding claim 3, Pippel discloses that the lay-down roller assembly 60 is capable of having an inclined rotation axis (Figure 14).

Regarding claim 4, Chitwood discloses that the heating device may comprise a thermostatically controlled electrical resistance elements which would be capable of electronic control (column 6, lines 19-22).

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Regarding claims 5 and 6, Pippel discloses that the lay down roller assembly 60 comprises a plurality of rollers so arranged as to be capable of pressing adjacent portions of the transfer tape (Figures 6 and 14; column 9, lines 35-65).

Regarding claim 7, Pippel discloses that the formed substrate is supported by a lay down surface or mandrel (reinforcement pad) to support the tapes as they are laid down (Figures 1 and 16; column 1, lines 49-60; column 6, lines 39-42).

Regarding claim 8, Pippel discloses that the apparatus is typically arranged in cooperation with an autoclaving oven wherein the taped substrate is heated to cure and consolidated the laid down tape sections (column 1, lines 33-37).

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pippel in view of Shinno and Chitwood as applied to claims 1 through 8 above, and further in view of Kam et al. (US Patent No. 4,086,378).

The references as combined above disclose an apparatus which includes a means for the oven heat treatment of the tape coated substrate. Although they do not specifically disclose the oven types set forth in applicant claim 9, it would have been obvious to one of ordinary skill in the art to utilize any suitable curing oven motivated by the fact that such ovens, such as the air circulating oven taught by Kam et al. (column 5, lines 2-22), are known in the art as suitable for the heat treatment of tape lay-up composites of the type formed by the apparatus resulting from the combination of the Pippel in view of Chitwood as detailed above.

Drawings

6. The drawings were received on 03 June 2005. These drawings are acceptable.

Response to Arguments

7. Applicant's arguments filed 03 June 2005 have been fully considered but they are not persuasive.

8. In response to applicant's argument that Pippel is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the examiner disagrees with the applicant's contention this is an unrelated field. Both applicant's invention and Pippel are machines which are used to place a tape or other film like material onto a surface. Applicant's arguments mostly have to deal with their assertion that claim 1 relates to decorating a "profiled bar" while Pippel applies the material to a "mandrel". Both machines are in the same field of endeavor whether they apply a film or a decoration to a "profiled bar" or a mandrel. Additionally, "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

9. In response to applicant's argument that their invention relates to a technical field of decorating a profiled bar by transferring onto the surface of the bar a decoration initially printed on a strip-like support, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re*

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Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Pippel in view of Shinno and Chitwood has all the structural limitations of applicant's claims and is capable of doing applicant's intended use.

10. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

11. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

12. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no

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event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis
Primary Examiner
Art Unit 1734

SP
August 17, 2005